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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,439	07/19/2001	Sheila Sellers	109.0020	1811

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EXAMINER

BORLINGHAUS, JASON M

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,439

Applicant(s)

SELLERS ET AL.

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1 –10 are objected to because of the following informalities: Lack of antecedent basis.

Regarding Claim 1, Claim 1 is objected to because of the following informalities: lack of proper antecedent basis. Claim 1 cannot be clearly understood as it is unclear whether the applicant is referring to the before mentioned decision analysis software when the applicant states “the decision analysis process” (see line 11 of the claim) or another, as yet unmentioned, decision analysis process. Examiner suggests that the applicant replace the word “the” with the word “a” before the phrase “decision analysis process” in line 11 of the claim for the purpose of improving language clarity.

Regarding Claims 2 – 5, Claims 2 – 5 are objected to because they are dependent on Claim.

Regarding Claim 6, Claim 6 is objected to because of the following informalities: lack of proper antecedent basis. Claim 1 cannot be clearly understood as it is unclear whether the applicant is referring to the before mentioned decision analysis software when the applicant states “the decision analysis process” (see line 12 of the claim) or another, as yet unmentioned, decision analysis process. Examiner suggests that the applicant replace the word “the” with the word “a” before the phrase “decision analysis process” in line 12 of the claim for the purpose of improving language clarity.

Regarding Claims 7 – 10, Claims 7 – 10 are objected to because they are dependent on Claim 6.

Proper correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 – 10 of copending Application No. 09/788,132. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only change is that a servicer is using the proposed system on behalf of the borrower, rather than the

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borrower using the proposed system for him/herself. It is old and well known in the art to have a servicer (ie. credit counselor, banker, mortgage broker, loan officer...) obtain and process financial information from the borrower to obtain a loan on behalf of the borrower being serviced.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-3, 5, 6-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Dhar (US Patent Pub. 2002/0040339 A1).

Regarding Claim 1, Dhar discloses a system for automatically obtaining loan decisions, comprising:

- a network of personal computers (clients) connected into a network administered by a central server computer (web server). ("The web server is in network communication with the Internet. The web server provides the Internet interface for the client's web browser. Specifically, the web server hosts dynamic web

pages and provides an interface for clients to interact with the application server and the database server.” - see page 1, paragraph 0017);

- each personal computer (client) in the network including a network interface for transmitting servicer inputs to (“Each request from the client proceeds through the web server, which transmits the required information to the application server.” – see page 1, paragraph 0018), and receiving outputs from, the server computer (“Assuming that the borrower scores high enough to qualify for one or more of the instant offer loans, the system compiles a list of instant offers for that consumer and displays them on a web page for the consumer's review.” – see page 9, paragraph 0104);
- each personal computer (client) in the network further including display screens for receiving inputs from (“...a website interface providing a credit application form for a consumer to complete, the website interface providing a field for the consumer to select a category of loan offerings..” – see Claim 1. A display screen would be inherent in collecting input through a website interface.), and providing outputs (“Assuming that the borrower scores high enough to qualify for one or more of the instant offer loans, the system compiles a list of instant offers for that consumer and displays them on a web page for the consumer's review.” – see page 9, paragraph 0104) to, a servicer on behalf of a financially troubled borrower, including inputs and outputs relating to a proposed workout;
- the central server computer (application server) having a central processing unit (workflow/decision engine) that runs automatic workout decision analysis

software ("When the lending institution receives the application data, the back-end loan workflow engine is activated instantly to perform automatic decision analysis for credit scoring, ratio analysis and other credit checks to meet the selection criteria of each financial institution." – see page 4, paragraph 0041) and has access to electronically stored information relating to the financially troubled borrower and other information necessary to the decision analysis process ("The workflow engine accepts web-based loan applications, processes the loan applications programmatically, and renders a loan decision within seconds." – see abstract); and

- the central server computer transmitting to the servicer on behalf of the financially troubled borrower, automatically over the network, approval of the proposed workout if certain predefined parameters (checklists) are met ("The workflow engine uses checklists to evaluate loan applications." – see abstract) and, if the predefined parameters are not met, providing further instructions to the financially troubled borrower ("If the bank rejects the application, a rejection notice is sent to the applicant." – see page 9, paragraph 0100).

While Dhar does not teach a servicer utilizing the system (ie. transmitting inputs and receiving outputs), Dhar's intended use does not differentiate between Dhar's invention and the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding Claim 2, Dhar discloses a system, wherein the personal computers are connected into the network using an Internet connection. ("The web server is in network communication with the Internet. The web server provides the Internet interface for the client's web browser. Specifically, the web server hosts dynamic web pages and provides an interface for clients to interact with the application server and the database server." - see page 1, paragraph 0017).

Regarding Claim 3, Dhar discloses a system, wherein the network interface is web-based. ("The web server is in network communication with the Internet. The web server provides the Internet interface for the client's web browser. Specifically, the web server hosts dynamic web pages and provides an interface for clients to interact with the application server and the database server." - see page 1, paragraph 0017).

Regarding Claim 5, Dhar discloses a system, wherein if the user inputs fail to satisfy predetermined guidelines (checklists), the user receives a message informing the user that the system cannot be used. ("Rejection notice sent to applicant" – see figure 7, 114, 116, 118 and 120).

Regarding Claim 6, Claim 1 recites similar limitations to Claim 6 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1. Claim 1 related to a system that was anticipated by Dhar and, therefore, Claim 6 was anticipated by Dhar due to the same reasoning.

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Regarding Claim 7, Claim 2 recites similar limitations to Claim 7 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 2. Claim 2 related to a system that was anticipated by Dhar, and, therefore, Claim 7 was anticipated by Dhar due to the same reasoning.

Regarding Claim 8, Claim 3 recites similar limitations to Claim 8 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 3. Claim 3 related to a system that was anticipated by Dhar, and, therefore, Claim 8 was anticipated by Dhar due to the same reasoning.

Regarding Claim 10, Claim 5 recites similar limitations to Claim 10 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 5. Claim 10 related to a system that was anticipated by Dhar, and, therefore, Claim 5 was anticipated by Dhar due to the same reasoning.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dhar in view of Fletcher (US Patent 6,112,190).

Regarding Claim 4, Dhar does not teach a system, wherein the user selects a workout type among a menu of predefined workout types.

Fletcher discloses a system, wherein the user selects a workout type among a menu of predefined workout types (pulldown menu – see figure 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Dhar by incorporating predefined workout types, as was done by Fletcher, to streamline the web-based interface for the system.

Regarding Claim 9, Claim 4 recites similar limitations to Claim 9 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 5. Claim 9 related to a system that was obvious, and, therefore, Claim 4 was obvious due to the same reasoning.

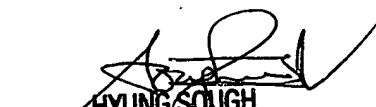
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited to McCauley (US Patent 6,067,533), VanLeeuwen (US Patent Pub 2002/0123949), Quackenbush (US Patent Pub 2003/0172014), Davidson (US Patent 5,699,527), and Norris (US Patent 5,870,721), are considered to be relevant to the claimed invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (703) 308-9552. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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